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EXAMINER

MENON, KRISHNAN S

ART UNIT PAPER NUMBER

1723

DATE MAILED: 04 10 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/021,029

Applicant(s)

SHIMADA, KAZUNORI

Examiner

Krishnan S Menon

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1-20 are pending. Claims 6-8 are withdrawn from consideration as non-elected claims.

#### ***Election/Restrictions***

Applicant's election with traverse of group I, claims 1-5 and 17-20 in Paper No. 7 is acknowledged.

Election requirement between groups I (claims 1-5 and 17-20) and II (claims 9-16) is withdrawn.

Regarding group III (claims 6-8): The traversal is on the ground(s) that there is no serious burden on the examiner (MPEP article 803). This is not found persuasive because the inventions in group III, claims 6-8: method of making) are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, like spray coating.

The requirement is still deemed proper and is therefore made FINAL.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1, 2, 4, 5, 9, and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huder (US 5,714,065) in view of Markonius (US 5,861,430).

Huder teaches a water insoluble antibacterial member (Fig. 1 col. 3 lines 3-10) as in claim 1. The antimicrobial agent in Huder's teaching is not a propolis component. Markonius teaches propolis as an antimicrobial component. It would be obvious to one of ordinary skill in the art to use the antimicrobial agent as taught by Markonius in the teaching of Huder because of the advantage of it being anti bacterial and anti viral agent (col. 2 lines 5-8) and its compatibility with different types of carriers (col. 7 lines 45-67).

Claim 2 adds the further limitations of the base member being ceramic (col. 2 lines 30-35).

Independent Claims 4 and 5 add the limitations of process of forming the member. These claims are product by process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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Claim 9: Huder teaches a water insoluble antibacterial filter (Fig 1 col 3 lines 3-10) wherein the antimicrobial agent is disposed in the flow passage. The antimicrobial agent in Huder's teaching is not a propolis component. Markonius teaches propolis as an antimicrobial component. It would be obvious to one of ordinary skill in the art at the time of invention to use the antimicrobial agent as taught by Markonius in the teaching of Huder because of the advantage of it being anti bacterial and anti viral agent (col 2 lines 5-8) and its compatibility with different types of carriers (col 7 lines 45-67).

Claims 11 and 12 add further limitations of the process of making the filter. These are product by process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claim 13: Huder teaches a water insoluble antibacterial filter (Fig 1 col 3 lines 3-10) wherein the antimicrobial agent is disposed in a base member, the ceramic filter (8-fig 1). The antimicrobial agent in Huder's teaching is not a propolis component. Markonius teaches propolis as an antimicrobial component. It would be obvious to one of ordinary skill in the art to use the antimicrobial agent as taught by Markonius in the teaching of Huder because of the advantage of it being anti bacterial and anti viral agent (col 2 lines 5-8) and its compatibility with different types of carriers (col 7 lines 45-67).

The base member is ceramic as in claim 14 (col 3 lines 3-10).

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Claims 15 and 16 add further limitation of the process of making the ceramic filter. They are product by process claims "[E]ven though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim 17: Huder teaches a water insoluble antibacterial container (Fig 1 col 3 lines 3-10) wherein the antimicrobial agent is disposed in a ceramic base member (8-fig 1). The antimicrobial agent in Huder's teaching is not a propolis component. Markonius teaches propolis as an antimicrobial component. It would be obvious to one of ordinary skill in the art to use the antimicrobial agent as taught by Markonius in the teaching of Huder because of the advantage of it being anti bacterial and anti viral agent (col 2 lines 5-8) and its compatibility with different types of carriers (col 7 lines 45-67).

The base member is ceramic as in claim 18 (col 3 lines 3-10)

Claims 19 and 20 add the further limitation of the process of making, and are product by process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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2. Claims 3 and 10 are rejected Huder in view of Markonius as in claims 1 and 9 above and further in view of Totani et al (US 5,011,062).

Huder in view of Markonius does not teach an ore as the base member. Totani teaches using an ore as carrier for the antimicrobial agent (col 3 lines 20-35). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Totani in the teaching of Huder in view of Markonius for the antimicrobial member for efficient carrying of the agent.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 703-305-5999. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Krishnan Menon  
Patent Examiner  
April 7, 2003

JOSEPH DRODGE  
PRIMARY EXAMINER

Joseph Drodge  
JOSEPH DRODGE  
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